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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,590	01/16/2001	Kurt M. Kessler	HMR 2041 US NP1	4289

5487 7590 06/19/2003

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EXAMINER

CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 06/19/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/760,590

Applicant(s)

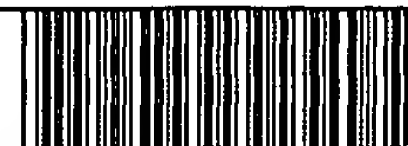
Kessler

Examiner

Celia Chang

Art Unit

1625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED May 2, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on May 2, 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment

3. ☐ Applicant's reply has overcome the following rejection(s):
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attachment

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

CELIA CHANG
PRIMARY EXAMINER
ART UNIT 1625

Art Unit: 1625

--ATTACHMENT TO ADVISORY--

The after final response with declaration of Shutske have been considered but are deemed to be not persuasive for the following reasons:

1. There is no good reason that why the declaration could not be submitted earlier since it was an opinion on terminology.
2. The opinion affidavit does not provide evidence as to "what" is the nature of the product disclosed by Kim '934. It has been clearly delineated in the office action that at col. 9 lines 19-57, the process for obtaining the product methanol was explicitly disclosed which indicated that the "product" was "title compound (formula at lines 25-30) methanol". It does not matter whether the nomenclature of the product was according to standard practice or not, the product made by the process, is the one rendered the instant claims prima facie. Applicants provided no factual evidence that the "product" can not be a clathrate. It is noted that in patent law, it is the "product" that has patentability not its name. Please note that a patent can be obtained even if the name or nature of the product can not be ascertained i.e. a product by process.
3. Further, factual evidence in the field which can be employed to support the position that the character of Kim's '934 product by its process being clathrate can be found in issued patent US 6,576,647 which disclosed that it is conventionally known that cis-2-(2-chlorophenyl)5,7-dihydroxy-8[4R-(3S-hydroxy-1-methyl)piperidiny]-4H-benzopyran-4-one will crystallized into solvates with numerous solvents such as ethanol, DMSO, methanol.... (see col.1 background). Further, at col. 8 the ethanol solvate of the compound was in possession by Bafus et al. '647 (copy will not be provided since it is assigned to the same assignee), thus a 102(f) issue, which is new, must be resolved.